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DOCKET NO.: 205057US0SRD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: : GROUP ART UNIT: 1634

Minako HIJIKATA, et al.

SERIAL NO.: 09/813,990 : EXAMINER: Arun K. CHAKRABARTI

FILED: MARCH 22, 2001

FOR: GENETIC POLYMORPHISM OF MXA PROTEIN AND USE THEREOF

RESPONSE TO RESTRICTION REQUIREMENT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON D.C. 20231

SIR:

Responsive to the Official Action dated November 19, 2002, Applicants elect, with traverse, Group I, Claims 18-49, drawn to polynucleotides, for further prosecution.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 18-49, drawn to polynucleotides;

Group II: Claims 50-57, drawn to method of nucleic acid hybridization; and

Group III: Claims 58-61, drawn to transgenic animals.

Applicants elect, with traverse, Group I, Claims 18-49, drawn to polynucleotides, for further prosecution.

Applicants note that the claims of Groups II and III depend directly from the claims of Group I, as such these claims are inseparable.

The Office has characterized the inventions of Groups I and II as related as “a product and process of use.” The Office states that the claimed polynucleotides of Group I can be used in “nucleic acid hybridization of Group II or can be used to make RNA and protein or can be used to make antisense nucleic acid for gene therapy.” However, there is no evidence of record to show that the alleged methods are materially different from the process of Group II. Moreover, the claims of Group II depend directly from the claims of Group I, as such the polynucleotides of Group I *are* used in the process of Group II. Therefore, the Office merely states many conclusions lacking support. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

In regard to Groups I and III, the Office has characterized the relationship between these two groups as product and process of use. Citing MPEP §806.05(h), the Office concludes that the product as claimed in Group I can be used “in the making of transgenic animal of Group III or can be used to make RNA and protein or can be used to make antisense nucleic acid for gene therapy.” However, the Office has not provided reasons and/or examples to support this conclusion. Further, the Office has failed to show that the alleged use of the claimed composition is materially different from the claimed use. Moreover, the claims of Group III depend directly from the claims of Group I, as such the polynucleotides of Group I *are* used in the process of Group III. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

The Office has characterized the inventions of Groups II and III as “unrelated.” Citing MPEP §806.04 and §808.01, the Office concludes that the Groups are distinct inventions because the “method of nucleic acid hybridization of Group II are not disclosed as

capable of use together with the transgenic animal of Group III and they have different modes of operation, different functions, or different effects.” Applicants traverse the Restriction Requirement on the ground that the Office merely states a conclusion while failing to show any support that the inventions of Groups II and III are “unrelated”. Therefore, the Office merely states a conclusion lacking support. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

Applicants traverse the Restriction Requirement on the additional grounds that the Office has not shown that a burden exists in searching all the claims of the present application.

Moreover, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

For the reasons set forth above, Applicants contend that the Restriction Requirement is improper and should be withdrawn.

Additionally, MPEP §821.04 states:


...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Applicants respectfully submit that should the elected group be found allowable, non-elected process claims should be rejoined.

Applicants further submit that this application is in condition for examination on the merits and an early notification to that effect is earnestly solicited.

Respectfully submitted,

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